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MAY 25 2004

In re Application of
Heikkila et al.
Application No. 09/913,331
Filed: August 13, 2001
Attorney Docket No. 3952-36

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: ON PETITION
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This is a decision on the petition filed March 18, 2002, requesting under 37 CFR 1.59 that the USPTO expunge and correct assignment records, which is being treated as a petition under 37 CFR 1.183 that the USPTO waive the rules. The delay in treating the petition is sincerely regretted.

The petition is **dismissed**.

Petitioners seek extraordinary relief in that through error, an assignment intended for another unrelated application was submitted and recorded at the USPTO on October 11, 2001 at reel/frame 12259/659 against this application. Petitioners note that another assignment that was intended for this application was likewise submitted and recorded by the USPTO on October 11, 2001, at reel/frame 12368/669 against this application. As such, petitioners seek expungement of the incorrect assignment.

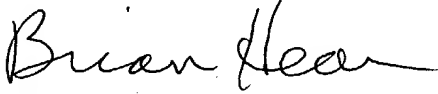
Initially, while petitioners seek an extraordinary remedy under 37 CFR 1.182 or 1.183, it is pointed out that the USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 or 1.183 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pats. 1982).

As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 U.S.C. § 261 and 37 CFR 3.11. However, the recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. See 37 CFR 3.54. As such, it is not necessary, or desirable, for the USPTO to "void" or "expunge" the assignment of which petitioner complains. For example, an error(s) in a recorded assignment document is not corrected by "voiding" the previous document, but simply by recording a corrected document. See MPEP 323. Rather, as noted in MPEP 323, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment

document will not be expunged, even if it is subsequently found to be invalid. In re Raney, 24 USPQ2d 1713 (Comm'r Pat. 1992).

Since, as here, applicants have recorded a correct assignment against this application, all that the records of the USPTO need show is that the assignment recorded against this application at reel/frame 12259/659 is a document submitted for recordation in error. Such alleged error may be corrected under the rules currently in effect by simply supplying a copy of this petition (or other document setting forth the same relevant facts) along with a recordation cover sheet and the \$40 fee, and asking that Assignment Branch record the clarifying document against the above-identified application as an "other document" within the meaning of 37 CFR 3.11(a).

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-1820.

A handwritten signature in cursive script that reads "Brian Hearn".

Brian Hearn
Senior Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner for
Patent Examination Policy